No. 17-571

In the Supreme Court of the United States

FOURTH ESTATE PUBLIC BENEFIT CORPORATION,
PETITIONER

v.

WALL-STREET.COM, LLC, ET AL.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE SUPPORTING RESPONDENTS

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QUESTION PRESENTED

Section 411(a) of the Copyright Act provides that "no civil action for infringement of the copyright in any United States work shall be instituted until" either (1) "registration of the copyright claim has been made in accordance with this title" or (2) "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused." 17 U.S.C. 411(a). The question presented is as follows:

Whether a copyright owner may commence an infringement suit after delivering the proper deposit, application, and fee to the Copyright Office, but before the Register of Copyrights has acted on the application for registration.

TABLE OF CONTENTS

Page

Interest of the United States 1
Statement 1
Summary of the argument 11
Argument:
Under Section 411(a), a copyright-infringement suit may not be filed until the Register of Copyrights has either approved or refused registration of the work 14
A. The text and structure of the Copyright Act support the court of appeals' interpretation of Section 411(a) 14
B. The history of the Copyright Act supports the court of appeals' interpretation of Section 411(a) 22
C. Petitioner's contrary arguments are unavailing 26
Conclusion 33
Appendix A — United States Copyright Office letter to William Brown (Apr. 4, 2016) 1a
Appendix B — United States Copyright Office letter to William Brown (Aug. 4, 2017) 3a

TABLE OF AUTHORITIES

Cases:

Algonquin Music, Inc. v. *Mills Music, Inc.*, 93 F. Supp. 268 (S.D.N.Y. 1950) 23
Bouvé v. *Twentieth Century-Fox Film Corp.*, 122 F.2d 51 (D.C. Cir. 1941) 24
Carr v. *United States*, 560 U.S. 438 (2010) 30
Clark v. *Rameker*, 134 S. Ct. 2242 (2014) 17
Eldred v. *Ashcroft*, 537 U.S. 186 (2003) 33
Feist Publ'ns, Inc. v. *Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) 10
Golan v. *Holder*, 565 U.S. 302 (2012) 31
Hall v. *United States*, 566 U.S. 506 (2012) 18

Cases—Continued: Page

Lumiere v. *Pathé Exch., Inc.*, 275 F. 428 (2d Cir. 1921) 23
Mazer v. *Stein*, 347 U.S. 201 (1954) 30
Petrella v. *Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962 (2014) 16
Reed Elsevier, Inc. v. *Muchnick*, 559 U.S. 154 (2010) 6, 31
Rosedale v. *News Syndicate Co.*, 39 F. Supp. 357 (S.D.N.Y. 1941) 23
Roth Greeting Cards v. *United Card Co.*, 429 F.2d 1106 (9th Cir. 1970) 17, 25
Star Athletica, L.L.C. v. *Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017) 14
Vacheron & Constantin-Le Coultre Watches, Inc. v. *Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958) 23, 24
Vermont Agency of Natural Res. v. *United States ex rel. Stevens*, 529 U.S. 765 (2000) 21
Washingtonian Publ'g Co. v. *Pearson*, 306 U.S. 30 (1939) 3, 32
Wheaton v. *Peters*, 33 U.S. (8 Pet.) 591 (1834) 2
White-Smith Music Publ'g Co. v. *Goff*, 187 F. 247 (1st Cir. 1911) 25

Statutes and regulations:

Act of May 31, 1790, ch. 15, 1 Stat. 124 2
§ 2, 1 Stat. 124 3
§ 3, 1 Stat. 125 ..... 15, 22
§§ 3-4, 1 Stat. 125 2
Act of July 8, 1870, ch. 230, 16 Stat. 198:
§§ 90-91, 16 Stat. 213 3
§ 91, 16 Stat. 213 ..... 15, 22
§ 97, 16 Stat. 214 3
§§ 99-100, 16 Stat. 214 ..... 3, 22

Statutes and regulations—Continued: Page

Act of Feb. 19, 1897, ch. 265, 29 Stat. 545 3
Act of Mar. 4, 1909, ch. 320, 35 Stat. 1075:
§ 9, 35 Stat. 1077 3
§ 10, 35 Stat. 1078 4
§ 12, 35 Stat. 1078 ..... 4, 12, 17, 23
Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (17 U.S.C. 101 *et seq.*) 1
17 U.S.C. 101 6
17 U.S.C. 102(a) 1
17 U.S.C. 106 2
17 U.S.C. 205(c) 28, 29
17 U.S.C. 205(c)(1) 29
17 U.S.C. 406(a) 29, 30
17 U.S.C. 406(a)(1) 29
17 U.S.C. 408 ..... 16, 20
17 U.S.C. 408(a) 4, 6, 27
17 U.S.C. 408(b) 4
17 U.S.C. 408(c)(3) 27
17 U.S.C. 408(f) 21, 22, 32
17 U.S.C. 408(f)(2) 22
17 U.S.C. 408(f)(3) 12, 20
17 U.S.C. 409 ..... 4, 16, 20
17 U.S.C. 410 4
17 U.S.C. 410(a) 4, 9, 11, 16, 21
17 U.S.C. 410(b) 5
17 U.S.C. 410(c) 7, 31
17 U.S.C. 410(d) 6, 12, 21, 28, 29
17 U.S.C. 411 6
17 U.S.C. 411(a) ..... *passim*
17 U.S.C. 411(b)(1) 6, 16
17 U.S.C. 411(c) 27, 28, 32

Statutes and regulations—Continued: Page

17 U.S.C. 411(c)(2) 27
17 U.S.C. 412 ..... 7, 27, 32
17 U.S.C. 412(2) 27, 28
17 U.S.C. 501(a) 2
17 U.S.C. 502 2
17 U.S.C. 503 2
17 U.S.C. 504 2
17 U.S.C. 504(a)(2) 7
17 U.S.C. 504(c) 7
17 U.S.C. 504(c)(1) 33
17 U.S.C. 504(c)(2) 33
17 U.S.C. 505 ..... 2, 7
17 U.S.C. 508 20
17 U.S.C. 508(a) 19
17 U.S.C. 508(b) 20
17 U.S.C. 508(c) 20
17 U.S.C. 705 29
17 U.S.C. 705(a) 4, 15, 32
17 U.S.C. 705(b) 4, 32
17 U.S.C. 708 4
17 U.S.C. 708(a) 28
17 U.S.C. 708(a)(1) 4, 12, 20
37 C.F.R.:
Section 201.3(d)(7) 5
Section 202.16(b)(1) 22
Section 202.16(c) 22

Miscellaneous: Page

Caruthers Berger, *Study No. 18: Authority of the Register of Copyrights to Reject Applications for Registration* (1959), *reprinted in* Subcomm. on Patents, Trademarks, and Copyrights, Senate Comm. on the Judiciary, 86th Cong., 2d Sess., *Copyright Law Revision: Studies Prepared Pursuant to S. Res. 240, Studies 17-19* (Comm. Print 1960) 25

Black's Law Dictionary:

(revised 4th ed. 1968) 15, 20

(10th ed. 2014) 15

134 Cong. Rec. 28,302-28,303 (1988) 6

Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 87th Cong., 1st Sess. (Comm. Print 1961) 25, 26

83 Fed. Reg. 24,054 (May 24, 2018) 5

H.R. Rep. No. 199, 115th Cong., 1st Sess. (2017) 5

H.R. Rep. No. 1476, 94th Cong., 2d Sess. (1976) 24, 30

Prof. Benjamin Kaplan, *Study No. 17: The Registration of Copyright* (1958), *reprinted in* Subcomm. on Patents, Trademarks, and Copyrights, Senate Comm. on the Judiciary, 86th Cong., 2d Sess., *Copyright Law Revision: Studies Prepared Pursuant to S. Res. 240, Studies 17-19* (Comm. Print 1960) 2

U.S. Copyright Office:

Compendium of U.S. Copyright Office Practices (3d ed. 2017) 4, 5, 8, 10, 16

Public Catalog, http://cocatalog.loc.gov (last visited Oct. 18, 2018) 5

Miscellaneous—Continued: Page

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Webster's Third New International Dictionary (1966)..... 15

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INTEREST OF THE UNITED STATES

This case presents the question whether a copyright owner may commence a suit for copyright infringement before the Register of Copyrights, as director of the Copyright Office, has acted on the owner's application for registration. The United States has a substantial interest in the resolution of that question, as the Copyright Office is responsible for copyright registration. At the Court's invitation, the United States filed a brief as amicus curiae at the petition stage of this case.

STATEMENT

1. The Copyright Act of 1976 (Copyright Act or 1976 Act), 17 U.S.C. 101 *et seq.*, grants copyright protection to "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. 102(a). Among other rights and benefits, copyright protection confers on

owners the exclusive rights to copy, distribute, and perform the works. 17 U.S.C. 106. Anyone who violates these rights is "an infringer of the copyright" and may be held liable to the copyright owner for actual or statutory damages, injunctive relief, and attorney's fees and costs. 17 U.S.C. 501(a), 502, 503, 504, 505.

Beginning with the initial Copyright Act, Act of May 31, 1790 (1790 Act), ch. 15, 1 Stat. 124, Congress has provided for the official registration of copyrighted works. See Prof. Benjamin Kaplan, *Study No. 17: The Registration of Copyright* (1958), *reprinted in* Subcomm. on Patents, Trademarks, and Copyrights, Senate Comm. on the Judiciary, 86th Cong., 2d Sess., *Copyright Law Revision: Studies Prepared Pursuant to S. Res. 240, Studies 17-19*, at 9-27 (Comm. Print 1960). Congress has generally required that such registration be completed before a copyright owner could commence an action for infringement.

a. The 1790 Act required each author first to deposit a copy of his work prior to its publication with the clerk's office of the district court where the author resided, so that the clerk could "record the same forthwith, in a book to be kept by him for that purpose," and then to publish notice of the copyright record in a newspaper for four weeks. 1790 Act §§ 3-4, 1 Stat. 125. Under that law, compliance with the deposit requirement was a prerequisite to copyright protection. See *Wheaton* v. *Peters*, 33 U.S. (8 Pet.) 591, 663 (1834) (noting that "a right accrues under the act of 1790, from the time a copy of the title of the book is deposited in the clerk's office"). The 1790 Act conferred on each author a cause of action, "from and after the recording the title of any" copyrighted work, through which an infringer

could be required to forfeit any infringing works and to pay damages. 1790 Act § 2, 1 Stat. 124.

Over the next century, Congress consolidated the registration functions within the Library of Congress, while maintaining registration as a precondition to copyright protection. In 1870, Congress required each author to "deposit in the mail" a copy or description of her work for delivery to the Library of Congress before publication, so that the Librarian of Congress could "record the name of such copyright book, or other article, forthwith in a book to be kept for that purpose." Act of July 8, 1870 (1870 Act), ch. 230, §§ 90-91, 16 Stat. 213. The 1870 Act also provided that "no person shall maintain an action for the infringement of his copyright" in a work unless he included in the work a notice that it had been "[e]ntered according to act of Congress * * * in the office of the librarian of Congress, at Washington," § 97, 16 Stat. 214, and it conferred a cause of action available "after the recording of the title" of the copyrighted work, §§ 99-100, 16 Stat. 214. In 1897, Congress established the office of the Register of Copyrights within the "Copyright Department" (now the Copyright Office) of the Library of Congress and directed the Register to "perform all the duties relating to copyrights." Act of Feb. 19, 1897, ch. 265, 29 Stat. 545.

In 1909, Congress changed prior law to provide that registration was not a precondition to copyright protection for published works. See Act of Mar. 4, 1909 (1909 Act), ch. 320, § 9, 35 Stat. 1077 ("[A]ny person entitled thereto by this Act may secure copyright for his work by publication thereof with the notice of copyright required by this Act."); *Washingtonian Publ'g Co.* v. *Pearson*, 306 U.S. 30, 37 (1939). The 1909 Act continued to provide for registration of works by the Register of

Copyrights, 1909 Act §§ 10, 12, 35 Stat. 1078, however, and it stated that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration of such work shall have been complied with," § 12, 35 Stat. 1078.

b. The current Copyright Act continues to provide for the registration of works by the Register as director of the Copyright Office. 17 U.S.C. 408(a), 410. A copyright owner generally "may obtain registration of the copyright claim by delivering to the Copyright Office" two deposit copies of the work, an application containing information about the work, and the application fee. 17 U.S.C. 408(a) and (b), 409, 708. When the Register receives those materials, she "examin[es]" the "material deposited" to determine whether the work "constitutes copyrightable subject matter" and whether "other legal and formal requirements of [the Copyright Act] have been met." 17 U.S.C. 410(a).

If "after examination" the Register determines that the work is copyrightable and that all legal and formal requirements are satisfied, "the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office." 17 U.S.C. 410(a). The copyright owner's original application fee covers the "issuance of a certificate of registration if registration is made." 17 U.S.C. 708(a)(1). The Office also creates an official public record of registrations, entering into its records catalog the "records of * * * registrations" and making public "the articles deposited in connection with completed copyright registrations." 17 U.S.C. 705(a) and (b); see U.S. Copyright Office, *Compendium of U.S. Copyright Office Practices* § 209 (3d ed. 2017) (*Compendium*). Records of post-

1977 registered works are available on the Internet to be searched by the public. See U.S. Copyright Office, *Public Catalog*, http://cocatalog.loc.gov. If the Register instead "determines that * * * the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason, the Register shall refuse registration." 17 U.S.C. 410(b).

The examination process often involves a dialogue between the Copyright Office and the applicant. In the course of such correspondence, an owner may clarify the scope of his application or may withdraw or otherwise abandon his claim. *Compendium* §§ 605.3(B), 605.7, 605.9. Depending on the necessary correspondence and the complexity of the legal issues presented, the time to complete this process varies. The average time for the Copyright Office to resolve a registration application is approximately seven months. See U.S. Copyright Office, *Registration Processing Times* 1, https://www.copyright.gov/registration/docs/processing-times-faqs.pdf (*Registration Processing Times*).[1] For an additional fee, however, an applicant may request expedited processing, and "the Office will make every attempt to examine the application or the document within five working days." *Compendium* § 623.4; see *id.* § 623.6; see also 37 C.F.R. 201.3(d)(7) ($800-per-

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[1] After fiscal year 2016, the Copyright Office has "engaged in a variety of regulatory reforms that are projected to increase the efficiency of various registration, recordation, or licensing activities." 83 Fed. Reg. 24,054, 24,055 (May 24, 2018) (citation omitted). Additionally, the Office is modernizing its information-technology systems over the next five years. *Ibid.*; see H.R. Rep. No. 199, 115th Cong., 1st Sess. 19 (2017) (stating that the "modernization of the [Office's] electronic copyright registration system is of utmost importance").

application fee for expedited processing). If the Register ultimately grants registration of a work, the effective date of that registration is the date on which the Copyright Office first received a proper application, deposit, and fee. See 17 U.S.C. 410(d).

c. Although registration is not a "condition of copyright protection," 17 U.S.C. 408(a), the current Copyright Act provides a number of incentives for owners to seek registration promptly.

As most relevant here, Section 411(a) states that "no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title." 17 U.S.C. 411(a).[2] That provision establishes a non-jurisdictional "precondition to filing a claim" of infringement. *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154, 157 (2010). Unless the owner has knowingly submitted an inaccurate application, the Register's issued certificate of registration "satisfies the requirements of" Section 411. 17 U.S.C. 411(b)(1). Section 411(a) further provides that, "[i]n any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil

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[2] In general, "United States work[s]" are works first published in the United States or created exclusively by domestic authors. 17 U.S.C. 101. Amicus International Trademark Association suggests (Br. 7-13) that Section 411(a) may not satisfy the requirements of the Berne Convention. Congress addressed that issue, however, by excusing owners of non-United States works from the requirement to register before filing suit. See 17 U.S.C. 411(a); 134 Cong. Rec. 28,302-28,303 (1988); see also Pet. Br. 10 n.6. There is no dispute in this case that the works at issue are "United States work[s]." 17 U.S.C. 411(a).

action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. 411(a). Within the 60-day period after such notice has been served, the Register may intervene "with respect to the issue of registrability of the copyright claim." *Ibid.*

The Copyright Act creates additional incentives for prompt submission of applications to register authors' works. The Act authorizes awards of statutory damages, costs, and attorney's fees to prevailing copyright owners. 17 U.S.C. 504(a)(2) and (c), 505. Subject to limited exceptions, however, those remedies are available only for acts of infringement commenced after the effective date of registration. 17 U.S.C. 412. In addition, a "certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate." 17 U.S.C. 410(c).

2. Petitioner Fourth Estate Public Benefit Corporation generates online news content and licenses its news articles to others while retaining ownership of its works. Pet. App. 2a, 16a. Respondents Wall-Street.com and its owner initially entered into such a licensing agreement to display petitioner's works online. *Ibid.* That agreement required respondents to cease displaying those works if respondents ever cancelled the agreement. *Id.* at 2a, 18a-19a. Petitioner alleges that respondents cancelled their licensing agreement but continued to display petitioner's news articles on their website without permission. *Ibid.*

In early March 2016, petitioner deposited a number of articles with the Copyright Office and submitted an application and fee for registration of an automated

computer database. See App., *infra*, 3a-4a. "For purposes of copyright registration, a database is defined as a compilation of digital information" where the "selection, coordination, and/or arrangement of data or other component elements within the database is sufficiently creative to warrant registration." *Compendium* §§ 1117.1, 1117.2. Petitioner did not request expedited processing of its copyright claim.

On March 11, 2016, before the Register had acted on the application, petitioner filed this copyright-infringement suit. Pet. App. 15a-22a. The complaint stated that petitioner had filed "applications to register [its] articles with the Register of Copyrights immediately prior to the filing of this case," and that petitioner would file the certificate of registration with the court when it received the certificate. *Id.* at 18a. The complaint further stated that "when issued by the Register of Copyrights the registration certificate will be dated prior to the filing of this action." *Ibid.* Petitioner sought injunctive relief, actual or statutory damages, and attorney's fees and costs. *Id.* at 21-22a.

After the commencement of this suit, Copyright Office records indicate that the Office sent a letter to the contact listed in petitioner's application, informing him that petitioner's check for the application fee could not be processed. App., *infra*, 1a-2a. A week later, on April 11, 2016, the Copyright Office received a collectable fee, permitting it to examine petitioner's application materials. See *id.* at 3a-4a.

3. a. While petitioner's application for registration remained pending, the district court dismissed the complaint without prejudice. Pet. App. 11a-14a. While recognizing that registration is not "a jurisdictional requirement" for a copyright-infringement suit, the court

explained that the absence of registration "is nonetheless a procedural bar to infringement claims." *Id.* at 13a. The court rejected petitioner's argument that having "an application to register * * * pending at the time of the suit * * * is sufficient to survive a motion to dismiss." *Ibid.*

b. The court of appeals affirmed. Pet. App. 1a-10a. The court held that, for purposes of Section 411(a)'s directive that no copyright-infringement suit may be instituted "until preregistration or registration of the copyright claim has been made in accordance with this title," 17 U.S.C. 411(a), registration of a copyright "'has [not] been made in accordance with . . . title [17]' * * * until 'the Register . . . registers the claim.'" Pet. App. 6a (quoting 17 U.S.C. 410(a), 411(a)) (brackets in original). The court explained that "[t]he Copyright Act defines registration as a process that requires action by both the copyright owner and the Copyright Office." *Ibid.* Although the Act requires the owner to commence the registration process by submitting a deposit, application, and fee, it directs the Register to "examine[]" the submissions and to "determine[]" whether the work is copyrightable before approving or refusing registration. *Ibid.* The court concluded that "[f]iling an application does not amount to registration" as that term is used in the Copyright Act, *ibid.*, and that petitioner's arguments grounded in "legislative history and policy" could not overcome Section 411(a)'s plain meaning, *id.* at 8a-9a.

4. In August 2017, after the court of appeals' mandate had issued, Copyright Office records indicate that the Office notified petitioner of the Register's disposition of petitioner's application. App., *infra*, 3a-9a. The

Office stated that, if the claim were ultimately registered, the effective date of registration would be April 11, 2016, when a proper fee was received. *Id.* at 3a-4a.[3] It further explained, however, that the Register was refusing registration. *Id.* at 3a.

Noting that petitioner had sought registration on the ground that its news articles comprised a database, the Copyright Office explained that the registrability of a database, as a type of compilation, depends on whether the selection and arrangement of the elements displays sufficient originality to qualify as a work of authorship. App., *infra*, 7a (citing *Feist Publ'ns, Inc.* v. *Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)). The Office concluded that the selection and arrangement of petitioner's database, in which individual articles were arranged in chronological order, lacked sufficient originality to warrant registration. *Ibid.* The Office also noted that the articles appeared to be from a news website, and that for registration purposes the *Compendium* distinguishes between websites and databases. *Id.* at 8a (citing *Compendium* § 1002.6).[4]

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[3] Petitioner's application fell within the category of copyright claims with the longest processing times. See *Registration Processing Times* 1. Applications submitted by mail that require further correspondence constitute about two percent of all applications. *Ibid.* The processing time for those applications varies between three and 37 months depending on the issues that arise. *Ibid.*

[4] Petitioner notes (Br. 16) that AHN Feed Syndicate (petitioner's licensee) had previously made "group registration for databases containing the same type of material at issue here." But the merits of the Copyright Office's decision to refuse registration—including the relevance of the Office's recent clarification of the distinction between websites and databases—are not at issue in this Court.

SUMMARY OF THE ARGUMENT

Under Section 411(a) of the Copyright Act, a copyright-infringement suit may not be filed until the Register of Copyrights has either approved or refused registration of the work.

A. Several aspects of Section 411(a) itself, and of the larger statutory scheme, support the court of appeals' conclusion that "registration of [a] copyright claim has been made," 17 U.S.C. 411(a), only when the Register has approved an application. In this context, the term "registration" is naturally read to denote the Register's entry of a claim of copyright into the official register. Section 411(a)'s requirement that registration have been made "in accordance with this title" reinforces this understanding. Although the owner of a copyright initiates the registration process by submitting specified materials to the Copyright Office, registration "in accordance with" Title 17 occurs only "after examination" of that submission by the Register, who "determines" whether the submission is "acceptable for registration" and (if the statutory requirements are satisfied) "register[s] the claim." 17 U.S.C. 410(a) and (d).

Section 411(a)'s second and third sentences bolster that conclusion. The second sentence's exception to the registration requirement, which allows an infringement suit to be commenced when "registration has been refused," would be superfluous if "registration" were "made" at the moment a copyright owner submits the required materials to the Register. And Section 411(a)'s third sentence, which authorizes the Register to intervene in cases where registration is refused, could not fully serve its intended purpose if the applicant could initiate suit, and the district court potentially

could decide the merits, before the Register had rendered her registration decision.

Other Copyright Act provisions confirm the court of appeals' interpretation. The Act describes a copyright owner's submission of his deposit, application, and fee as an "application for registration," not as "registration" itself. 17 U.S.C. 408(f)(3) (capitalization altered). The Act states that the fees paid for filing an "application * * * for registration" should also cover "the issuance of a certificate of registration if registration is made." 17 U.S.C. 708(a)(1). The Act's backdating provision, under which the effective date of registration is the day on which an application, deposit, and fee are submitted in proper form, 17 U.S.C. 410(d), would be unnecessary if the submission itself "made" registration. And the Act's preregistration regime, which allows owners of copyrights in certain classes of works to sue for infringement before registration, would serve little purpose if every copyright owner could always file suit as soon as he applied for registration.

B. The Copyright Act's history likewise supports the court of appeals' interpretation of Section 411(a). The immediate predecessor to Section 411(a) provided that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration of such work shall have been complied with." 1909 Act § 12, 35 Stat. 1078. Courts interpreted that provision to require dismissal of any infringement suit that was filed before the owner had obtained a certificate of registration. Some courts further held that, even after registration had been refused, a copyright owner could not institute an infringement suit unless it

first obtained a writ of mandamus compelling the Register to grant registration of the copyright.

By authorizing a copyright owner to institute an infringement suit when he has delivered "the deposit, application, and fee required for registration * * * and registration has been refused," 17 U.S.C. 411(a), the 1976 Act abrogated the requirement to seek a writ of mandamus after such a refusal. But Section 411(a)'s first sentence continues in effect the pre-existing general rule that no infringement suit can be filed unless the Copyright Office has registered the relevant copyright.

C. Petitioner's contrary arguments are unpersuasive. Petitioner principally contends that, while the term "registration" can refer to the actions of either the copyright owner or the Register, the phrase "registration has been made" throughout the Act refers only to the copyright owner's submission of an application for registration. But petitioner's examples demonstrate only that, while the copyright owner's actions are necessary to initiate the registration process, "registration" is not "made" unless and until the Register approves an application. Indeed, several provisions use the phrase "registration has been made" (or a close variant) in ways that make sense only if that phrase refers to the Register's ultimate approval of the application.

Petitioner also contends that, because the Act's exclusive rights, right to sue, and remedies are ultimately available whether the Register approves or refuses registration, waiting for the Register of Copyrights to determine registration would serve no useful purpose. But while a copyright owner may sue regardless of the Copyright Office's conclusion as to registrability, the court will benefit from knowing what that conclusion is. And

although petitioner expresses concern that the registration requirement may temporarily prevent copyright owners from enforcing their rights, that is the intended result of a congressional design to encourage prompt registration for the public benefit. Congress has provided various means of mitigating these risks, in circumstances where they are particularly acute, while maintaining a strong incentive for prompt submission of applications to register copyrights more generally.

ARGUMENT

UNDER SECTION 411(a), A COPYRIGHT-INFRINGEMENT SUIT MAY NOT BE FILED UNTIL THE REGISTER OF COPYRIGHTS HAS EITHER APPROVED OR REFUSED REGISTRATION OF THE WORK

The text, structure, and history of the Copyright Act confirm that, under Section 411(a), the Register of Copyrights must have acted on an application for copyright registration—either by approving or refusing registration—before the copyright owner may institute an infringement suit. The court of appeals correctly affirmed the dismissal of petitioner's suit, which was instituted before the Register had acted on petitioner's application for registration. Petitioner's contrary arguments are unavailing.

A. The Text And Structure Of The Copyright Act Support The Court Of Appeals' Interpretation Of Section 411(a)

In construing Section 411(a), this Court begins "with the text, giving each word its 'ordinary, contemporary, common meaning,'" and "'look[s] to the provisions of the whole law to determine [the Section's] meaning.'" *Star Athletica, L.L.C.* v. *Varsity Brands, Inc.*, 137 S. Ct. 1002, 1010 (2017) (citations omitted). Section 411(a)

states that "no civil action for infringement of the copyright in any United States work shall be instituted until" either (1) "registration of the copyright claim has been made in accordance with this title," or (2) "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused." 17 U.S.C. 411(a). Several aspects of Section 411(a) itself, and of the larger statutory scheme, support the court of appeals' conclusion that "registration of [a] copyright claim has been made," *ibid.*, only when the Register has approved an application.

1. The term "registration" in Section 411(a) is most naturally read to refer to the Copyright Office's official recording of an accepted copyright claim. The term "registration" signifies an authoritative act of "[r]ecording" or "inserting in an official register." *Black's Law Dictionary* 1449 (revised 4th ed. 1968); see *Webster's Third New International Dictionary* 1912 (1966) ("something registered" or "an entry in a register"); see also *Black's Law Dictionary* 1474 (10th ed. 2014) ("The act of recording or enrolling."). Since 1790, federal copyright law has consistently provided for recordation or registration of copyrights *by a government official*, whether the copyright was "record[ed]" by the clerk of the district court (1790 Act § 3, 1 Stat. 125), "record[ed]" by the Librarian of Congress (1870 Act § 91, 16 Stat. 213), or maintained as "records of * * * registrations" by the Register of Copyrights (17 U.S.C. 705(a)).

Where copyrighted works are involved, "registration" thus denotes the act of the eponymous Register of Copyrights in entering a claim of copyright into the official register. See 17 U.S.C. 705(a) (requiring public catalog of "records of * * * registrations" and "the articles

deposited in connection with completed copyright registrations"); *Compendium*, Glossary 14 ("Registration involves examining the claim, and if the claim is approved by the U.S. Copyright Office, numbering the claim, issuing a certificate of registration, and creating a public record."). If Congress had intended to adopt the rule that petitioner advocates, it could have omitted the requirement that "registration * * * ha[ve] been made," and could have combined language from the first two sentences of Section 411(a), to provide that "no civil action for infringement of the copyright in any United States work shall be instituted until the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form."

Section 411(a)'s requirement that "registration" have been "made in accordance with this title" reinforces this natural meaning. 17 U.S.C. 411(a). Under Title 17, the copyright owner initiates the registration process by delivering a deposit, application, and fee to the Copyright Office. See 17 U.S.C. 408, 409. Registration "in accordance with" Title 17 occurs, however, only "after examination" of those submissions by the Register, who "determines" whether the submissions are "acceptable for registration." 17 U.S.C. 410(a) and (d). Only then does the Register "register the claim," by recording the work as copyrightable, and "issue to the applicant a certificate of registration under the seal of the Copyright Office." 17 U.S.C. 410(a); see 17 U.S.C. 411(b)(1) (explaining that the "certificate of registration satisfies the requirements of [Section 411(a)]"). Thus, in the ordinary case, "both the certificate and the original work must be on file with the Copyright Office before a copyright owner can sue for infringement." *Petrella* v. *Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1977 (2014).

2. The second sentence of Section 411(a), which creates an exception to the registration requirement for circumstances in which the Register refuses registration, confirms that conclusion. That sentence provides: "In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. 411(a). Thus, a copyright owner who has submitted a procedurally compliant application package may file an infringement suit once the Register has refused registration. That exception would be superfluous if an applicant could commence suit under the first sentence of Section 411(a) as soon as he had submitted the required materials. See *Clark* v. *Rameker*, 134 S. Ct. 2242, 2248 (2014) ("[A] statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous.") (citation omitted).

Petitioner reads (Br. 30-31) Section 411(a)'s second sentence to mean that, although a copyright owner may initiate suit as soon as the required materials have been submitted, he must notify the Register about the suit if the Register refuses registration while the litigation is ongoing. But if Congress had intended that result, it could have made notice to the Register a precondition for the copyright owner to "maintain" or "continue with" the suit. The 1909 Act's precursor to current Section 411(a) stated that no infringement action "shall be maintained" without complying with the registration requirement. 1909 Act § 12, 35 Stat. 1078; see *Roth Greeting Cards* v. *United Card Co.*, 429 F.2d 1106, 1108 (9th

Cir. 1970) (noting that courts were "divided on the question of whether 'maintained,' as used in [the 1909 Act,] mean[t] 'begun' or 'continued'"). Section 411(a)'s second sentence, however, provides that, in circumstances where registration has been refused, "the applicant is entitled to *institute* a civil action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights." 17 U.S.C. 411(a) (emphasis added). That language makes clear that, in cases where the Register refuses registration, the plaintiff must notify the Register at the time suit is commenced.

Under petitioner's approach, moreover, the term "registration" would have a quite different meaning in Section 411(a)'s second sentence than it has in the first. Petitioner construes (Br. 21) that term in the first sentence to refer solely "to the action of the copyright owner and not to the action of the Copyright Office." But the second sentence, which addresses cases in which "registration has been refused," 17 U.S.C. 411(a), clearly uses the term to refer to the Register's disposition of the application. "[I]dentical words and phrases within the same statute should normally be given the same meaning," *Hall* v. *United States*, 566 U.S. 506, 519 (2012) (citation omitted), and that common-sense understanding applies with particular force when the same word appears in consecutive sentences of a single statutory subsection.

Petitioner asserts (Br. 30) that the first two sentences of Section 411(a) would "contradict each other" if the "the second sentence w[ere to] mean that a suit for infringement may be instituted even though registration had *not* been made." But that is the point. As explained above, Section 411(a)'s second sentence is best understood to create an exception to the general

rule that "registration" must be "made" before an infringement suit may be commenced. To be sure, Congress could have communicated more precisely the relationship between the two sentences. But the word "however" in the second sentence at least makes clear that Congress understood that sentence as a departure from, or qualification of, the rule announced in the sentence that precedes it. Taken as a whole, Section 411(a) provides that a copyright owner may initiate infringement litigation if he has submitted a compliant application, deposit, and fee, and the Register has acted on that submission, either by granting or denying it. There is nothing substantively contradictory about that regime.

3. Petitioner's approach would also subvert the congressional purpose that underlies Section 411(a)'s third sentence, which authorizes the Register to intervene within 60 days in cases where registration has been refused. See 17 U.S.C. 411(a) (authorizing the Register to "become a party to the action with respect to the issue of registrability of the copyright claim" when she has refused registration). The evident purpose of that provision is to ensure that the Register can explain to the court in the infringement suit why she concluded that the requirements for registration were not satisfied. That provision could not fully serve its intended purpose if the applicant could initiate suit, and the district court potentially could decide the case on the merits, before the Register had either rendered her registration decision or received the mandated notice.

Petitioner observes (Br. 39 n.24) that, for each copyright-infringement suit, the clerk of the district court where suit is filed must notify the Register of Copyrights within one month of "the names and addresses of the parties and the title, author, and registration

number of each work involved in the action." 17 U.S.C. 508(a). The context in which that provision appears, however, makes clear that its purpose is to enable the Register to make the relevant information "a part of the public records of the Copyright Office," 17 U.S.C. 508(c), not to enable the Register to participate in such suits. Unlike Section 411(a), Section 508 does not authorize the Register to intervene in infringement suits. And under Section 508(b), the district court must likewise inform the Register "[w]ithin one month after any final order or judgment is issued in [an infringement] case," when participation by the Register is no longer possible. 17 U.S.C. 508(b).

4. Other Copyright Act provisions reinforce the conclusion that the Register must approve or refuse registration before the copyright owner may institute an infringement suit. Section 408 describes the copyright owner's submission to the Copyright Office of his deposit, application, and fee as an "application for registration." 17 U.S.C. 408(f)(3) (capitalization altered); see *Black's Law Dictionary* 127 (revised 4th ed. 1968) (defining "application" as "[t]he act of making a request for something"); see 17 U.S.C. 409 (requirements for "application for registration"). That language indicates that submission of the required materials is an action distinct from "registration" itself.

Section 708 states that the fees paid by a copyright owner for filing an "application under section 408 for registration of a copyright claim" must cover "the issuance of a certificate of registration *if registration is made*." 17 U.S.C. 708(a)(1) (emphasis added). That language again assumes that the copyright owner's "application" under Section 408 is distinct from the "ma[king]" of "registration," *and* that a certificate of registration will

be issued "if registration is made." That will be true only if the Register's approval of an application, rather than the applicant's submission of it, is the act by which "registration" is "made." See 17 U.S.C. 410(a) (providing that the Register will "register the claim and issue to the applicant a certificate of registration" if she determines that "the material deposited constitutes copyrightable subject matter" and that all "other legal and formal requirements" are met). Petitioner contends that Section 708 "sheds little light" (Br. 27) on the proper construction of Section 411(a), because Section 708 was added in 1982. But it is "well established that a court can, and should, interpret the text of one statute in the light of text of surrounding statutes, even those subsequently enacted." *Vermont Agency of Natural Res.* v. *United States ex rel. Stevens*, 529 U.S. 765, 786 n.17 (2000).

Petitioner's approach would also render superfluous Section 410(d), under which "the effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights * * * to be acceptable for registration, have all been received in the Copyright Office." 17 U.S.C. 410(d). If "registration of [a] copyright claim" were "made" on the date those materials are submitted, 17 U.S.C. 411(a), there would be no need for the backdating rule of Section 410(d).

Petitioner's approach would also deprive the Copyright Act's "preregistration" regime of any significant practical effect. See 17 U.S.C. 408(f). Preregistration is available for limited classes of unpublished commercial works (such as prerelease versions of mainstream films) as to which the Copyright Office has found a history of infringement before commercial distribution.

Ibid. After the Copyright Office has conducted a truncated review based on a description of the unpublished work, see 17 U.S.C. 408(f)(2); 37 C.F.R. 202.16(b)(1) and (c), Section 411(a) permits the copyright owner to sue based on preregistration. The preregistration regime ensures that, for these limited classes of works, the copyright owner can seek a judicial remedy while its application for registration is pending before the Register. But if every copyright owner could file an infringement suit as soon as it had submitted the required deposit, application, and fee—*i.e.*, if the time required for the Register to examine and register a work would *never* delay the point at which an infringement suit could be commenced—there would be little need for the preregistration scheme.

B. The History Of The Copyright Act Supports The Court Of Appeals' Interpretation Of Section 411(a)

Since 1790, the Copyright Act has allowed a copyright owner to file an infringement suit only after the relevant authority has acted on an application to enter the copyright into the public record. The 1790 Act created a cause of action "from and after the recording the title of any copyright work," § 2, 1 Stat. 124-125, and directed the clerk of the district court to "record" the title "in a book to be kept by him for that purpose," § 3, 1 Stat. 125. The 1870 Act directed the Librarian of Congress to "record the name of" a copyrighted work upon his receipt of specified materials, § 91, 16 Stat. 213, and it authorized an infringement suit "after the recording of the title" of the work, §§ 99-100, 16 Stat. 214. The 1909 Act—the immediate predecessor to the current Copyright Act—provided that "[n]o action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of

copies and registration of such work shall have been complied with." § 12, 35 Stat. 1078. The courts' interpretation of the 1909 Act's registration requirement, and the subsequent changes that Congress made in drafting the 1976 Act, are particularly instructive here.

1. Courts interpreted the 1909 Act to require dismissal of any infringement suit that was filed before the owner had obtained a certificate of registration, even if the proper deposit had been made. See, *e.g.*, *Lumiere* v. *Pathé Exch., Inc.*, 275 F. 428, 430 (2d Cir. 1921) (affirming dismissal of suit and explaining that, "[w]hen this bill was filed, two copies of each of the [copyrighted] photographs had been deposited, but the registration required by the act had not been obtained"); *Algonquin Music, Inc.* v. *Mills Music, Inc.*, 93 F. Supp. 268, 268 (S.D.N.Y. 1950); *Rosedale* v. *News Syndicate Co.*, 39 F. Supp. 357, 357 (S.D.N.Y. 1941). As Judge Learned Hand explained, the 1909 Act required compliance with statutory provisions governing "'registration of [the] work'" as well as with those governing "'deposit of copies,'" and the court could "think of no other added condition for 'registration' but acceptance by the Register." *Vacheron & Constantin-Le Coultre Watches, Inc.* v. *Benrus Watch Co.*, 260 F.2d 637, 640-641 (2d Cir. 1958) (citation omitted).

The Second Circuit construed the 1909 Act to provide that, even after registration had been refused, a copyright owner could not commence an infringement suit unless it first obtained a writ of mandamus compelling the Register to grant registration of the copyright. See *Vacheron*, 260 F.2d at 639 ("Title 17 forbade any action for infringement of the copyright when the Register of Copyrights had refused * * * to accept [it].");

id. at 640 (discussing the use of mandamus in this context); see also, *e.g.*, *Bouvé* v. *Twentieth Century-Fox Film Corp.*, 122 F.2d 51, 52, 56 (D.C. Cir. 1941) (affirming entry of a writ of mandamus against the Register). By authorizing a copyright owner to "institute a civil action for infringement" when he has delivered "the deposit, application, and fee required for registration * * * and registration has been refused," the 1976 Act overrode that holding and made clear that a copyright owner need not obtain a writ of mandamus against the Register after such a refusal. 17 U.S.C. 411(a); see H.R. Rep. No. 1476, 94th Cong., 2d Sess. 157 (1976) (1976 House Report) ("The second and third sentences of section 411(a) would alter the present law as interpreted in *Vacheron*."). But the legislative history does not suggest that Congress intended to allow commencement of an infringement suit while the plaintiff's application for copyright registration remains pending. To the contrary, the House Report for the 1976 Act explained that "[t]he first sentence of section 411(a) restates the present statutory requirement that registration must be made before a suit for copyright infringement is instituted." 1976 House Report 157.

2. Petitioner contends (Br. 32-36) that courts of appeals construing the 1909 Act were divided on the question whether a copyright owner could sue for infringement while his application for registration was pending. Petitioner argues (*ibid.*) that Congress, in enacting the 1976 Act, adopted the view (which petitioner ascribes to the First and Ninth Circuits) that action by the Register should not be a precondition to suit. That argument reflects a misunderstanding of the pertinent pre-1976 decisions.

The First and Ninth Circuit decisions on which petitioner relies held at most that a copyright owner could file an infringement suit after "registration was refused." *White-Smith Music Publ'g Co.* v. *Goff*, 187 F. 247, 247 (1st Cir. 1911); see *Roth Greeting Cards*, 429 F.2d at 1108 (applications returned to change the "category of registration"). As explained above, the Second Circuit in *Vacheron* reached a contrary conclusion. See pp. 23-24, *supra*. The "unsettled question" that Congress resolved in 1976 thus was "whether a claimant who has fulfilled the procedural requirements (deposit, application, and fee) for registration but has been refused registration * * * must first secure registration by a mandamus action against the Register before he can maintain a suit for infringement." Caruthers Berger, *Study No. 18: Authority of the Register of Copyrights to Reject Applications for Registration* (Mar. 1959), *reprinted in* Subcomm. on Patents, Trademarks, and Copyrights, Senate Comm. on the Judiciary, 86th Cong., 2d Sess., *Copyright Law Revisions: Studies Prepared Pursuant to S. Res. 240, Studies 17-19*, at 97 (Comm. Print 1960) (recommending that copyright revision "clarif[y]" this question).

While the 1909 Act was in effect, the Register of Copyrights expressed the view that the rule announced in *Vacheron*, under which an unsuccessful copyright-registration applicant was required to obtain a writ of mandamus against the Register before commencing an infringement suit, was ill-advised. *Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, 87th Cong., 1st Sess. 75 (Comm. Print 1961). The Register explained that "two successive actions * * * may be an expensive

burden," and that such a requirement was not necessary to give the Register "the opportunity to advise the court of the reasons for refusing registration." *Ibid.* Instead, the Register recommended to Congress that "[r]egistration should continue to be a prerequisite to an action for copyright infringement. But where the procedural requirements for obtaining registration have been fulfilled and the Register of Copyrights refuses registration, the claimant should be entitled to bring an infringement suit if the Register is notified and permitted to become a party to the suit." *Id.* at 76. Section 411(a)'s second and third sentences implement that recommendation. The provision's first sentence, however, continues in effect the pre-existing general rule that the Register's approval of an application for registration is a prerequisite to the filing of a copyright-infringement suit.

C. Petitioner's Contrary Arguments Are Unavailing

1. a. Petitioner states (Br. 28) that, within the Copyright Act, the term "registration" sometimes refers to "the action of the copyright holder in applying for registration" and sometimes refers to "the action of the Copyright Office." Petitioner contends (Br. 21), however, that throughout the 1976 Act, "the phrase 'make registration' and its passive-voice counterpart 'registration has been made'" are used to refer "to the action of the copyright owner and not to the action of the Copyright Office." That argument is misconceived. To be sure, the copyright owner's actions are a necessary part of the overall registration process. As the court below correctly held, however, even after the copyright owner has performed his role in that process, "registration" can be "made" only after the Register has performed hers.

Petitioner relies (Br. 24-25) on provisions describing how the copyright owner initiates the registration process. See 17 U.S.C. 408(a) (providing that "the owner * * * may obtain registration of the copyright claim by delivering to the Copyright Office" the deposit, application, and fee); 17 U.S.C. 408(c)(3) (providing that, in certain circumstances, "a single renewal registration may be made for a group of works by the same individual author * * * upon the filing of a single application and fee"). But petitioner does not and cannot dispute that, even when an applicant has submitted a procedurally compliant application for copyright registration, the Register is charged with determining whether the registration criteria (procedural and substantive) are satisfied. The provisions cited above do not suggest that the applicant "obtain[s] registration," or that "registration" is "made," at the moment the application is submitted.

Petitioner's reliance (Br. 22-23) on the three-month deadlines for registration in Sections 411(c) and 412 is similarly unavailing. Section 411(c) creates a narrow exception to Section 411(a)'s registration requirement, allowing an individual to file an infringement action for a live broadcast before applying for registration—indeed, before the broadcast is even fixed in a tangible medium—but only if the copyright owner "makes registration for the work * * * within three months after its first transmission." 17 U.S.C. 411(c)(2). Section 412(2) creates an exception to the bar on statutory damages and attorney's fees for an "infringement of copyright commenced after first publication of the work and before the effective date of its registration," but again only if "registration is made within three months after the first publication." 17 U.S.C. 412(2).

Petitioner argues (Br. 24) that it would "make no sense" for a copyright owner's ability to invoke those provisions to depend on the speed with which the Copyright Office acts on a registration application. But the Court need not adopt petitioner's strained reading of Section 411(a) to avoid that problem. Section 410(d) provides that, no matter when the Copyright Office acts, if registration is ultimately granted, its effective date "is the day on which an application, deposit, and fee * * * have all been received in the Copyright Office." 17 U.S.C. 410(d). As long as the effective date of registration falls within the three-month windows defined by Sections 411(c) and 412(2), the requirements of those provisions are met.

b. Other Copyright Act provisions that use the phrase "registration has been made" (or a close variant) plainly refer to circumstances in which the entire registration process, including the Copyright Office's disposition of the copyright owner's application to register his work, has been completed.

As petitioner acknowledges (Br. 27), Section 708(a), which provides that the filing fees for an application also encompass the fees for "the issuance of a certificate of registration if registration is made," 17 U.S.C. 708(a), is one such example. See pp. 20-21, *supra*. The Act also provides that recording with the Office a transfer of ownership or other document pertaining to a copyrighted work gives the public "constructive notice" of the facts in the recorded document if, *inter alia*, "registration has been made for the work." 17 U.S.C. 205(c). And in certain circumstances, a copyright infringer who began the infringement in good faith under a purported license from someone other than the copyright owner has a "complete defense" to infringement liability unless

"registration for the work had been made in the name of the owner of copyright." 17 U.S.C. 406(a). These constructive-notice provisions assume that, once "registration has been made," a public record will have been created. That will be true if, but only if, "registration" is "made" when the Register approves an application and the Copyright Office enters the registration into her records catalog. See 17 U.S.C. 705; pp. 4-5, *supra*.

Petitioner contends (Br. 26-27) that the "constructive notice" described by Section 205(c) must apply *before* the Register creates a public record of the copyrighted work, because otherwise a third party would not have constructive notice between the time an application for registration was filed and the time the copyright was registered. But there is nothing "odd [or] counterintuitive" (Br. 27) about the conclusion that the public will not be deemed to have notice of a recorded transaction pertaining to a copyrighted work before the registration record for that work is publicly available. Indeed, the other requirement for such constructive notice—that the recorded document "would be revealed by a reasonable search under the title *or registration number* of the work"—assumes that the Register has completed the registration process by approving the application. 17 U.S.C. 205(c)(1) (emphasis added).

Petitioner argues (Br. 25 n.19) that, even under the government's construction of Section 406(a)(1), an innocent infringer may be liable for infringement that occurs before the Register creates a public record of the work, because the date the application is filed may be treated as the date of registration under the backdating provision in Section 410(d). Petitioner is mistaken. Section 406(a)(1) refers not simply to the date of "registration," but to the date that "registration had been made."

Congress's use of the past-perfect tense indicates that the statute protects any infringement that occurs before the Register's actual approval of the copyright owner's application, not only infringement that occurs before the backdated effective date. Cf. *Carr* v. *United States*, 560 U.S. 438, 449-450 (2010); see 1976 House Report 149 (explaining that, under Section 406(a), "the innocent infringer is given a complete defense unless a search of the Copyright Office records would have shown that the owner was someone other than the person" who provided the license).

2. Petitioner contends (Br. 36-43) that, because the Act's exclusive rights, right to sue, and remedies are ultimately available whether the Register approves or refuses registration, it would be "paradoxical" and "strange" to defer the filing of suit until the Register has acted on the application. But while Section 411(a) allows a copyright owner to sue regardless of the Copyright Office's conclusion as to registrability, the court in adjudicating an infringement suit will benefit from knowing what that conclusion is. That is especially true in cases involving novel issues of copyright law. See, *e.g.*, *Mazer* v. *Stein*, 347 U.S. 201, 213 (1954) (relying on "the practice of the Copyright Office" to determine whether works were copyrightable).[5]

Indeed, multiple Copyright Act provisions make clear that the Register's determination is expected to play a meaningful role in litigation. A timely obtained

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[5] Petitioner suggests (Br. 41) that the Copyright Office's views would be of little benefit in most cases because the "Office typically grants the overwhelming majority of applications." That suggestion elides the fact that the Office corresponds on a significant percentage of applications to cure some defect before registering the copyright claims. See *Registration Processing Times* 1.

certificate of registration constitutes "prima facie evidence of the validity of copyright and the facts stated in the certificate." 17 U.S.C. 410(c). Where registration is refused, the Register has a statutory right to intervene "with respect to the issue of registrability of the copyright claim." 17 U.S.C. 411(a). The congressional purposes underlying these provisions would be subverted if litigants could proceed with infringement suits before the Register had acted on their applications. And although petitioner suggests (Br. 39-41) several methods of staying infringement litigation while the Copyright Office processes an application, the Copyright Act does not leave the Register's role in litigation to judicial discretion. Instead, Congress reasonably chose to require the Register either to approve or refuse the application before an infringement suit can be "instituted." 17 U.S.C. 411(a).

By deferring the initiation of suit until the Register has determined whether a work is registrable, the Copyright Act also provides a significant incentive for copyright owners to begin the registration process before the work has been published or promptly after publication, rather than waiting until an infringement dispute arises. See *Golan* v. *Holder*, 565 U.S. 302, 314 n.11 (2012) (observing that Section 411(a) provides "incentives for authors to register their works"); *Reed Elsevier, Inc.* v. *Muchnick*, 559 U.S. 154, 158 n.1 (2010) (noting that "registration process" provides "incentives to encourage copyright holders to register their works"). Timely registration of creative works confers significant benefits on the Library of Congress and the public. Registration enables the Copyright Office to compile a public record of copyright claims, and the deposited copies provide definitive evidence of what the work was

at the time of registration. See 17 U.S.C. 705(a) and (b). These records serve as a valuable resource for persons who seek to use copyrighted works lawfully.

Petitioner expresses concern (Br. 37-38, 41) that, if a copyright owner is barred from commencing suit (including a suit for injunctive relief) while its application for registration is pending before the Register, the copyright may "temporarily" be rendered "valueless," and the Act's three-year statute of limitations may elapse before suit can be brought. But these risks strengthen the incentives for copyright owners to seek registration promptly, and they are a far cry from the permanent forfeiture that this Court considered in *Washingtonian Publishing Co.* v. *Pearson*, 306 U.S. 30, 39 (1939). Congress has provided various means of mitigating these risks in circumstances where they are particularly acute. See, *e.g.*, 17 U.S.C. 408(f) and 411(a) (conferring immediate right to sue after preregistration for classes of works with "a history of infringement prior to authorized commercial distribution"); 17 U.S.C. 411(c) (conferring immediate right to sue for infringement of live broadcasts); see also 17 U.S.C. 412 (permitting statutory damages and attorney's fees dating back to the filing of an application for registration). The Copyright Office also has established a mechanism for expedited consideration of applications for registration of all works. See pp. 5-6, *supra*.[6]

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[6] Petitioner observes (Br. 42) that the $800-per-application fee for expedited consideration could have a significant economic effect on persons who seek to register large collections of works. That fee pales, however, in comparison to the up-to-$30,000-per-work statutory damages that a successful infringement plaintiff may receive.

That Congress did not provide a wider panoply of judicial remedies for all copyright owners is not a reason to depart from the statute. The text of Section 411(a), and of the Copyright Act as a whole, is the best indication of the balance between competing objectives that Congress sought to draw. See *Eldred* v. *Ashcroft*, 537 U.S. 186, 212 (2003) ("[I]t is generally for Congress, not the courts, to decide how best to pursue the Copyright Clause's objectives."). Any adjustment of that balance is properly entrusted to Congress rather than to this Court.

CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted.

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OCTOBER 2018

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17 U.S.C. 504(c)(1); see 17 U.S.C. 504(c)(2) (allowing the court to increase an award of statutory damages to up to $150,000 per work in cases of willful infringement).

APPENDIX A

United States Copyright Office

Library of Congress · 101 Independence Avenue SE · Washington DC 20559-6000 · www.copyright.gov

Apr. 4, 2016

William Brown
922 Honeytree Lane, Apt. A
Wellington, FL 33414

Correspondence ID: 1-1I3Z4PR

RE: Group Registration . . . "Fourth Estate Public Benefit Corporation News Articles" Published January 1, 2016 to February 29, 2016—updated hourly.

Dear Mr. Brown:

We received your application, deposit, and payment to register your copyright claim. We are writing because the check you sent in payment of the filing fee was rejected by your bank as an uncollectible item.

If you wish register this claim, you must provide a new filing **fee.** In **addition,** the Office charges **$30.00** to service an uncollectible check. The full amount due is **$115.00.** You may send a check or money order with the accompanying reply sheet. Alternatively, you may pay the amount by credit card. See instructions on the reply sheet.

It is recommended that you respond as quickly as possible to establish an early effective date of registration. The effective date of registration for claims to copyright is established upon receipt of an application, deposit, **and valid filing fee.**

If we have not received your payment or credit card information within **45 days** of the date of this letter, we will cancel your registration. After that time, in order to register, you will have to file an entirely new claim, consisting of an application, deposit, and valid filing fee. If you have questions, please call 202-707-8443.

Sincerely,

Accounts Section
Receipt Analysis & Control Division
202-707-8443

Enclosure:
Copy of remittance
Reply Sheet
SL-4

APPENDIX B

United States Copyright Office

Library of Congress · 101 Independence Avenue SE · Washington DC 20559-6000 · www.copyright.gov

Aug. 04, 2017

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Correspondence ID: 1-2M4Y45H

RE: *Group registration of an automated database entitled "Fourth Estate Public Benefit Corporation News Articles", published January 1, 2016 to February 29, 2016—updated hourly* (1-3223995975)

Dear William Brown:

We are writing to refuse registration for *Group registration of an automated database entitled "Fourth Estate Public Benefit Corporation News Articles", published January 1, 2016 to February 29, 2016—updated hourly* ("the work") because this submission does not meet the legal or formal requirements for registration under the group database option or any other application option currently available.

Procedural History

Fourth Estate Public Benefit Corporation ("Fourth Estate") submitted this application, which was received on or about March 7, 2016. Due to Fourth Estate's

initial submission of an uncollectable check, the $85.00 filing fee was not received until April 11, 2016.

The receipt of a completed application, the appropriate fee, and an acceptable deposit can establish an effective date of registration (EDR) for purposes of title 17, section 410(d). But the establishment of that date is contingent on the issuance of a certificate of registration following the requisite examination for copyrightability and the legal and formal requirements of title 17, section 410(a). If the Office refuses registration, after determining compliance with the requirements of section 410(a), a court of competent jurisdiction may later find the work to be copyrightable and rely on the filing date as the EDR for purposes of title 17, section 412. 17 USC § 410(d).

In this case, not only did the uncollectable check delay the examination of this work and remove the claim from the U.S. Copyright Office's ordinary workflow, it also changed what would have been the effective date of registration, if the claim were ultimately registered, to the date when the proper fee was received by the Office.

Discussion

You have submitted multiple articles for registration with this application. As a general rule, a registration covers an individual work, and an applicant must submit a separate application, filing fee, and deposit copy for each work that is submitted for registration. In some cases, an applicant may register several works together on one application if one of the following limited exceptions applies: registering multiple works as a collective work, as an unpublished collection, as a "unit of

publication," or using one of several group registration options. For an in-depth discussion on the options for registering multiple works, see *Compendium of U.S. Copyright Office Practices*, Third Edition Chapter 1100.

In this case, it appears you have submitted these works for registration under the group database option. For purposes of copyright registration, a database is defined as a compilation of digital information comprised of data, information, abstracts, images, maps, music, sound recordings, video, other digitized material, or references to a particular subject or subjects. In all cases, the content of a database must be arranged in a systematic manner, and it must be accessed solely by means of an integrated information retrieval program or system with the following characteristics:

- A query function must be the sole means of accessing the contents of the database.
- The information retrieval program or system must yield a subset of the content, or it must organize the content based on the parameters specified in each query.

When seeking registration for a database or group registration of periodic revisions to a database, the applicant must deposit identifying portions of the updated content, with 50 representative pages marked to disclose the new material added on one representative publication date, along with a copy of the copyright notice (if any). In addition, an application for a group registration must include a descriptive statement containing specific information identified in the Office's regulations. *See* 37 CFR § 202.20(c)(2)(vii)(D).

For registration purposes, a database must be a copyrightable compilation, which is defined in the statute as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 USC 101 (definition of "compilation"). A database containing component works is considered a collective work, which is defined in the statute as a type of compilation. 17 USC 101 (definition of "collective work"), ("The term compilation includes collective works.") As such, the principal question in an application for registration of a database or group registration of periodic revisions to a database is whether there is sufficient creative selection, coordination, and/or arrangement of the elements to qualify as an original work of authorship. A database containing component works must demonstrate creative selection, coordination, and/or arrangement of the component works to be registrable as a copyrightable database. The copyrightability of component elements contained within a database will not suffice to demonstrate that a database is copyrightable or that multiple elements or works may be registered together in one application. Where sufficient creativity in the selection, coordination, and/or arrangement of elements is not demonstrated in the deposit material, the application for registration must be refused.

In this regard, the group database registration option is different from the Office's other group registration options. When the Office issues a registration for a group of published photographs or contributions to periodicals, the registration covers each individual on a separate basis and the group as a whole is not consid-

ered a compilation, a collective work, or a derivative work. 37 CFR 202.4(m); *Compendium* § 1104.4.

By contrast, the group database option covers new derivative versions of the selection, coordination, or arrangement of elements within the database. In essence, each update with the group is registered as a derivative compilation and/or derivative collective work. *Compendium* § 1104.4.

The critical copyrightable element in a compilation or collective work is not the copyrightability of individual elements, but rather the sufficiency of creative authorship in the selection, coordination, and/or arrangement of elements or works, such that the work as a whole qualifies as an original work of authorship in accordance with the principles of the statute and the decision in *Feist Publications, Inc., v. Rural Telephone Service Co.*, 499 U.S. 340 (1991).

The works you seek to register are multiple, separately published textual contributions. Although the application does not provide a year of completion or a date of first publication, the title space states that the contributions were published from January 1, 2015 through February 29, 2016 and that updates occur "hourly." The application describes the nature of authorship as "new matter: new text & revisions" and states that the work was not previously registered. The deposit material consists of separate articles, with publication dates ranging from January 1, 2016 through January 4, 2016.

The individual news articles submitted as the deposit material were submitted separately, and were selected and arranged in a manner that utterly lacks originality: in chronological order. As submitted, these articles

do not reveal any selection, coordination, and/or arrangement to support a claim to copyright in a compilation. Further, the registration materials do not demonstrate that these individual articles are even a part of a database. Instead, the articles appear to be from a news website. The *Compendium of U.S. Copyright Office Practices* clarifies the significant distinction between databases and websites for registration purposes. *Compendium* § 1002.6. Finally, Fourth Estate's application claims only in new text and revisions, and does not include a claim in selection, coordination, and/or arrangement. Therefore, as there is no original selection, coordination, and/or arrangement authorship evident in the registration materials, this submission is not eligible for registration under the group database and registration, as a compilation generally, or as a collective work. As a result, this claim must be refused.

In addition to the reasons discussed above, it is important to note that this application is deficient in meeting the formal requirements of the group database option in a number of other ways. Namely, Fourth Estate has not submitted the required Descriptive Statement; the application does not provide a representative publication date; and it lacks a limitation of the claim statement that would be necessary in relation to the application's references to "new matter" and "revised text" in the authorship statement. Were these the only defects in the application for registration, the application could be cured through correspondence and a submission of the omitted required information. However, in light of the inability for the work to qualify under the group database option, and the fact that the work does not qualify as a compilation or collective work, an at-

tempt to cure the application as submitted would be futile.

In order to register the articles contained within this claim, separate applications for each article must be submitted to the Copyright Office together with the proper application and proper fee. If the Office receives all of the required elements in proper form, it will examine the applications and the deposits to determine whether the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of title 17 have been met. If there is a need for expedited examination of such new applications, you may request special handling during the electronic application process or in writing with a paper application, explaining the basis for your need for expedited examination, together with payment of the required fee for this service.

This letter is for your information only. No reply is required. Should you choose to request administrative reconsideration of this decision, please follow the instructions on the enclosed reply sheet.

Sincerely,

Elizabeth Stringer
Supervisor
Literary Division
U.S. Copyright Office

Enclosures:
Reply Sheet